

**REMARKS**

This paper is responsive to the Office Action mailed August 16, 2005, relating to the above-identified application. Applicant has amended claims 1, 3, 9 and 10 and requests re-examination and reconsideration. Claims 1-10 remain pending. No new matter has been added.

**I. Summary of the Examiner's Rejections and Objections.**

Claims 1-10 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for lack of proper antecedent basis and other informal issues.

Claims 3 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,838,445 ("*Lanius*").

Claims 3, 7-9 and 10 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Japanese patent 3069109 ("JP '109") in view of U.S. Patent No. 5,390,815 ("*Spiegel*").

**II. Allowable Subject Matter**

Claims 1, 2 and 4-6 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph.

**III. Applicant's Response To the Examiner's Rejections.**

Applicants have amended claims 1, 3, 9 and 10 to overcome the Examiner's rejections. Applicants submits that *Lanius*, *Spiegel* and/or JP '109 fail to disclose, show, teach or suggest, either implicitly or explicitly, each and every element of Applicants' claimed subject matter, as amended, and

respectfully request the Examiner to withdraw such rejections. Applicants traverse the rejection of the aforementioned claims for the reasons set forth in greater detail below.

A. Legal Requirements

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 233 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc.*, 762 F.2d 724, 726 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984) (emphasis added). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

It is well-established that to establish prima facie obviousness, all the claim limitations must be taught or suggested by the prior art. In addition, there must be some teaching, motivation or suggestion in either the prior art, or the references themselves to make the combination asserted by the Examiner.

In *In re Lee*, the Federal Circuit held that the Patent & Trademark Office cannot rely on conclusory statements when dealing with particular

combinations of prior art and specific claims, but must set forth the rationale on which it relies. 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

“When patentability turns on the questions of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (‘the central questions is whether thee is a reason to combine [the] references,’ a question of fact drawing on the *Graham* factors).”

The factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 299 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (‘a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential component of an obviousness holding”’ (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (‘Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.’); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or

teaching of the desirability of making the specific combination that was made by the application); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))."

"The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed'); *In re Roufeet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references')."

Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

Measuring a claimed invention against the standard established in 35 U.S.C. §103 requires the oft-difficult, but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references in the then-accepted wisdom in the field. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id.*

Case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ 2d 164, 1617 (Fed. Cir. 1999). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *Id;* *See, e.g., Interconnect Planning Corp. v. File*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature

of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references.” *Dembiczak* at 1617; *In re Roffet*, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) (“The board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”).

The showing of such suggestion, teaching or motivation must be clear and particular. *Dembiczak* at 1617 (emphasis added); *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *Dembiczak* at 1617; *See, e.g. Elmurry v. Arkansas, Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 207, 217 (CCPA 1977).

Therefore, the Examiner must make particular findings regarding the locus of the suggestion, teaching or motivation to confine the prior art references. *Dembiczak* at 1617 (emphasis added).

B. §112, second paragraph Rejections

Claims 1, 3, 9 and 10 have been amended to overcome the Examiner’s rejection with respect to the term “said two of said wall” lacking antecedent basis. Accordingly, reconsideration and withdrawal of such rejection is requested.

With respect to the Examiner's rejection based on the interpretive assertion that the upper, lower and opposed first and second side panel edge portion in the drawing do not resemble a T-shape, Applicants must disagree. Figs. 5 and 7 clearly show the identified shape, which is not hour-glass shaped as asserted by the Examiner. Applicants further note that such a description as a T-shape most accurately describes this configuration and Applicants have done so consistently throughout this application. Finally, Applicants are their own lexicographer to describe such undefinable shapes in the manner they determine to be proper. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

C. §102(b) Rejection of Independent Claim 3.

The organizer case as defined in claim 3, as each amended, calls for, among other things:

"... said side edge flange portions being spaced apart a distance greater than said separation distance when said second joint formers are engaged with said first joint formers."

The structure and associated functionality of each and every element of the aforementioned limitation is not disclosed, taught or suggested, either implicitly or explicitly, in *Lanius*, *Spiegel* and/or JP '109, or any other reference of record either singularly or in combination, and the aforementioned limitation is not found in exactly the same situation and united in the same way to perform the same function, either implicitly or explicitly, in *Lanius*, *Spiegel* and/or JP '109, or any other reference of record either singularly or in

combination. Therefore, independent claim 3 cannot be anticipated by *Lanius*, *Spiegel* and/or JP '109, or any other reference of record. Applicants request a specific showing by the Examiner of the particular locus, other disclosure or teaching of each and every element of the aforementioned limitation in *Lanius*, *Spiegel* and/or JP '109, or any other reference of record either singularly or in combination. Absent such showing, the anticipation rejection of claim 3 by the Examiner is improper under 35 U.S.C. § 102(b) and MPEP § 706.02.

In *Lanius*, "the resilient flanges 44 are compressed so as to be substantially planar such that the divider can be slideably positioned between the [partitions]." Column 3, lines 14-17. "Because the flanges 44 are resilient and tend to flex toward the position shown in FIG. 2, when the divider member 40 is positioned between the partitions shown in FIG. 3, the flanges 44 resiliently engage the faces of the partitions and the ribs 50 of the flanges will engage the implementary ribs 36 of the partitions to prevent movement of the divider member 40 in the direction between the sides 16 and 18." Column 3, lines 17-24.

In view of the above, the extent of the planar web 42, the flange members 44 and/or free edge 48 cannot be greater than the separation distance of the partitions 24. To assert otherwise would require a structural configuration wholly incompatible with and contrary to the disclosure, teachings and suggestions of *Lanius*. The aforementioned limitation requires the distance between the side edge flange portions to be greater than the first and second joint formers when the insert divider is installed within the organizer case.

Consequently, Applicant submits that the anticipation rejection is improper under 35 U.S.C. § 102(b) and M.P.E.P. § 706.02 because *Lanius*, *Spiegel* and/or JP '109, or any other references of record either singularly or in combination, fail to disclose, teach or suggest all of the claimed elements of claim 3, as amended, in exactly the same situation and united in the same way to perform the same function. Accordingly, reconsideration and withdrawal of the rejection of claim 3 is respectfully requested.

Claims 7 and 8 directly or indirectly depend upon and include all the limitations of amended claim 3, and is allowable at least for the reasons associated with amended claim 3.

Accordingly, reconsideration or withdrawal of the rejection of claims 3, 7 and 8 is respectively requested.

D. §103(a) Rejection of Independent Claims 3, 9 and 10.

The organizer case as defined in claims 3, 9 and 10, as each amended, calls for, among other things:

... the side edge flange portions being spaced apart a distance greater than or at least 20% greater than the separation distance when the second joint formers are engaged with said first joint formers

The structure and associated functionality of each and every element of the aforementioned limitations is not disclosed, shown, taught or suggested, either implicitly or explicitly, in *Lanius*, *Spiegel* and/or JP '109, or any other reference of record, either singularly or in combination, and there is no teaching, motivation or suggestion to select and combine the reference relied

on as evidence of obviousness. Therefore, claims 3, 9 and 10, as amended, cannot be anticipated by *Lanius*, *Spiegel* and/or JP '109, or any other reference of record, either singularly or in combination. Applicants request a specific showing by the Examiner of the particular locus, other disclosure or teaching of each and every element of the aforementioned limitations within one of *Lanius*, *Spiegel* and/or JP '109, or any other reference of record, either singularly or in combination. Absent such showing, the obviousness rejection of claims 3, 9 and 10 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In particular, the Examiner admits that JP '109 fails disclose an insert divider that has side flange portions spaced apart greater than the separation distance between adjacent compartment walls. However, the Examiner relies on *Spiegel* to support the assertion that elastomeric ribbons 50 extending between slots 44 formed in side walls 42 would teach, motivate or suggest to one of skill in the art to form some of the dividers disclosed in JP '109 with a diagonal shaped body to form different shaped compartments.

Applicants submit that no such teaching, motivation or suggestion can be found in *Spiegel* or JP '109 to support the Examiner's assertion and request a showing of the specific laws of same. The elastomeric ribbons 50 are stretched to any desired tension to form any desired array of compartments. Column 2, lines 35-40. However, the divider inserts of JP '109 are solid, monolithic elements which extend from the bottom wall of the tray to the top and cannot be stretched or installed other than as shown and described. To

configure such divider inserts accordingly would be to teach away from the disclosure of JP '109. Further, the elastomeric ribbons 50 extend from slot 44 to slot 44 and engage the upstanding projections 46 which serve as hooks for the holes 52 in the elastic strip 50. Column 2, lines 32-35. Based on such teaching, modification to the JP '109 divider insert would render it incapable of performing the function for which it was designed. Moreover, the elastic strips 50 do not include any common components with the divider insert of JP '109. Accordingly, the divider insert of JP '109 cannot be modified by the elastomeric ribbon 50 of *Spiegel* to render obvious the aforementioned limitations.

Consequently, Applicant submits that the obviousness rejection is improper under 35 U.S.C. § 103(a) or M.P.E.P. § 706.02 because each and every limitation of the amended claims 3, 9 and 10 are not disclosed, shown, taught or suggested in *Lanius*, *Spiegel* and/or JP '109, or any other reference of record, either singularly or in combination. Accordingly, reconsideration and withdrawal of the rejection of amended claims 3, 9 and 10 is respectfully requested.

Claims 7 and 8 directly or indirectly depend upon and include all the limitations of amended claim 3 and are allowable at least for the reasons associated with amended claim 3.

Accordingly, reconsideration or withdrawal of the rejection of claims 3 and 7-10 is respectively requested.

**CONCLUSION**

Based on the above amendments and remarks, the Applicant submits that claims 1-10 are now in proper condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 22-0259 for any payment in connection with this communication, including any fees for extensions of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

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